



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/535,516

05/18/2005

Yuichi Okazaki

2008_1523

4280

513 7590 03/17/2009

WENDEROTH, LIND & PONACK, L.L.P.

1030 15th Street, N.W.,

Suite 400 East

Washington, DC 20005-1503

EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

03/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,516	Applicant(s) OKAZAKI ET AL.	
	Examiner M. Sager	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/18/05, 8/24/05 and 1/10/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/18/05, 8/24/05 and 1/10/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method is neither tied to another statutory process nor transforms underlying subject matter to another state or thing so as to produce a concrete, tangible and useful result. *Diamond v Diehr*, 450 USPQ2d 175, 184 (1981). Further, the claims pertain to a program that is non-statutory since a program per se is non-statutory subject matter.

See guidance at

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_101_05_15_2008.pdf.

The determination whether claimed invention is statutory is a threshold determination based upon law. On October 26, 2005, the USPTO published Interim Guidelines for

Examination of Patent Applications for Patent Subject Matter Eligibility. See:

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

This guideline details a procedure for determining patent eligible subject matter. As to cited claims, the first step in this process is whether the claimed invention falls within one of enumerated categories. In this application, the claims 1-15 are drawn to a process – via claiming a “program”; however, a program per se is not statutory subject matter at least when not embodied on computer readable media since a program as claimed includes a program flow chart, program code on paper or other non-computer readable media so as not to preclude coding of a computer/processor. Also, the claimed step of invention of ‘changing a shape of the visual field area according to a shape of the main screen in the display area’ and a function for changing

Art Unit: 3714

a shape of the main screen according to a shape of the display unit or game proceeding' lacks (1) being tied to another statutory class or (2) transforming the underlying subject matter to a different state or thing. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972). Also, see Memorandums dated May 15, 2008, entitled 'Clarification of Process under 35 USC 101' and Jan. 7, 2009 by J. Love, entitled 'Guidance for Examining Process Claims in View of *In re Bilski*' at http://ptoweb/patents/3700/documents/101_process_%202008.pdf and http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf.

In view of the above analysis, applicant's invention of claims 1-15 is a process as a program but a program per se is non-statutory. Upon review of the claims as a whole, there is neither a transformation of the underlying subject matter to a different state or thing nor is the process tied to another statutory category. Accordingly, the claims are non-statutory under 35 U.S.C. 101. *In re Bilski* 545 F.3d 943, 88 USPQ2d 1385 (Fed Cir. 2008). However, claims 16-17 appear to be statutory.

Claim Interpretation

2. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) "adapted to" or "adapted for" clauses, (B) "wherein" clauses, and (C) "whereby" clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it

Art Unit: 3714

cannot be ignored in order to change the substance of the invention." Id. However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." Id. In this case, the 'wherein' clauses merely state the environment of use, or intended result or the clause fails to state a condition material to its patentability.

Allowable Subject Matter

3. Claims 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: the particular function for changing a shape as best understood appears to include allowable subject matter over art. As best understood, JP2001-353358 pertains to changing view angle of virtual camera/avatar in the virtual field/radar image and in main screen display based on position on game field such that when position is closer to midfield, the image view angle is wider while when the position is closer to a goal end area, the view angle is smaller. As best understood, JP2000-116946 pertains to changing view in radar image based on viewpoint of avatar in game. As best understood, EPO 1217600 pertains to changing game display area based on different aspect ratio of display which is relevant to the aspect ratio process of claims and despite that the reference does not relate to the radar image, the process remains relevant. As best understood, JP6-91054 pertains to changing the orientation of the radar image based on position of avatar on a game field [i.e. track] in the game. As best understood, JP 11-146979 (coincides with US

Art Unit: 3714

6409596) pertains to changing viewpoint of radar image based on view of avatar in game. As best understood, EPO 0911069 (that coincides with US 6431982 pertains to changing the size of the radar image window based on position of avatar in game such that when avatar is at/near midfield the radar image is larger than when avatar is close to a goal end area of play field. Bromley discloses virtual field inserts. Blanchard discloses adjusting reflectors based on different aspect ratio of projectors.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714